

REMARKS

Claims 1-15, all the claims pending in the application, stand rejected upon informalities and on prior art grounds. Applicants thank Examiner Choi for the withdrawal of the rejection of claims 1-5 under 35 U.S.C. §101 and the “partial” withdrawal of the rejection of claims 1-15 under 35 U.S.C. §112, 1st. Applicants respectfully traverse the remaining rejections of the 6/5/2009 Communication based on the following discussion. The following paragraphs have been numbered for ease of reference.

I. The 35 U.S.C. §112, First Paragraph, Rejection

[0001] Claims 1-15 stand rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. These rejections are traversed.

[0002] The 6/5/2009 Communication states that “[t]he specification does not discuss the possible consideration of factors other than the amount and/or duration of information exposure” (6/5/2009 Communication, p. 9, ll. 19-20).

[0003] Applicants previously drew the Examiner’s attention to Table 2 of the Published Application specifically reciting the last example exposure measure and subsequent textual description. Applicants apologize for failing to also draw the Examiner’s attention to the preceding paragraph which makes it clear that “[d]etails of the critical information that is temporarily stored between processing steps within each of said possible workflows...” is useful in determining the composition of the exposure costs measure.

[0004] Thus, one of ordinary skill in the art in possession of the information from the whole of the Published Application, including for example, paras. 29-44, would understand how

to use such information to select at least between the three examples provided in Table 2. The description of exemplary embodiments, such as the Analysis Engines depicted in Fig. 5 and described in paras. 35-44 of the Published Application provide additional guidance in the making and using of the invention. Applicants therefore respectfully request withdrawal of the rejection.

II. The 35 U.S.C. §112, Second Paragraph, Rejection

[0005] Claims 1-15 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These rejections are traversed.

[0006] Applicants note that Table 2 and paras. 29-44 provide guidance sufficient to choose between three exemplary exposure cost measures. These issues were similarly addressed in Applicants' prior Response. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. The Prior Art Rejections

[0007] Claims 1-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chan, et al. (U.S. Patent No. 6,889,375), hereinafter referred to as Chan, in view of Patrick C. K. Hung's "Secure Workflow Model," hereinafter referred to as Hung and further in view of Michael zur Muehlen's: Workflow-Based Process Controlling – Or: What Your Can Measure You Can Control," hereinafter referred to as Muehlen. Applicants note a minor typographical error in the Communication in which Hung, Patrick C.K. is referred to as "Patrick." Applicants understand this citation to refer to "Secure Workflow Model, April 2001, Patrick C.K. Hung, Hong Kong University of Science and Technology, 2001. Applicants request notification if this

assumption is incorrect. Applicants respectfully traverse the above-identified rejections.

[0008] As previously noted, Chan merely describes a system for application development. The system includes programming entities, which include a workflow and a container. A contract specifies an interaction between at least two programming entities.

[0009] While Hung merely describes Workflow Management Systems used to support many of the day to day workflows in large organizations. Hung asserts that one of the major problems with workflow management systems is that they often use heterogeneous and distributed hardware and software systems to execute a given workflow giving rise to decentralized security policies and mechanisms that need to be managed. Since security is an essential and integral part of workflows, the workflow management system has to manage and execute the workflows in a secure way. Hung notes that the prolific use of workflow management systems for critical and strategic applications gives rise to a major concern regarding the threats against integrity, authorization, and availability. Thus, Hung proposes an authorization model with a set of invariants for workflows from the aspects of agents, events and data, and assertedly proves that if they hold, the workflow execution is secure. Hung also describes the development of an authorization model based on a multi-layered state machine that separates the various aspects of control in a workflow and portrays it as a multi-layered architecture for analyzing the flow of authorizations.

[0010] Finally, Muehlen describes the analysis of automated business processes through the analysis of protocol data as one factor for the use of workflow management systems in organizations. As previously noted to the Examiner, Applicants discern no indication within Muehlen of a specification for a system or method but merely another research paper that

characteristically concludes that “[t]he active feedback of evaluation data on the modeling of workflow processes is a promising candidate for further research.” (Muehlen, p. 76, ll. 9-10).

[0011] The 6/5/209 Communication attempt to rebut Applicants’ criticism of Muehlen and Hung as lacking a presumption of enablement by stating that:

“A reference contains an “enabling disclosure” if the public was in possession of the claimed invention before the date of the invention. “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his [or her] own knowledge to make the claimed invention.” In re Donohue, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).”

[0012] Further, as per MPEP 2121.01 (II),

“Even if a reference discloses an inoperative device, it is prior art for all that it teaches.” *Beckman Instruments V. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, “a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103.” *Symbol Techs. Inc. V. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991).

[0013] Thus, the Applicant’s arguments are incorrect, and the Patrick and Muehlen references qualify as prior art for the purpose of determining obviousness and contain an “enabling disclosure” as defined by MPEP 2121.01. (6/5/2009 Communication, p. 3, ll. 1-16, emphasis added)

[0014] Applicants note that the Examiner’s conclusion does not follow from the citations. Moreover, the citations are inapposite with respect to Applicants’ previous assertions that non-patent literature is not examined and therefore not entitled to a presumption of enablement.

[0015] Applicants' noted these issues with respect to the Hung non-patent reference (previously referred to as Patrick), at for example, paras. 24-27 of the 3/4/2009 Response. Similarly problematic portions of the non-patent reference Muehlen were addressed in para. 30 of Applicants 3/4/2009 Response. Thus, In re Donohue is inapposite.

[0016] As to the language in the MPEP regarding an inoperative device, Applicants note that the cited section merely stands for the rather unsurprising proposition that a reference describing an inoperative device may actually teach something. However, by logical implication, the reference cannot be valid for proposition that it teaches an operative device. This was Applicants' point in the first instance. Mere citation in a U.S.P.T.O. Communication does not transmute the reference. This is recognized in the conclusion which uses the conditional form and states "may qualify as prior art." Applicants drew attention to these problems in the references.

[0017] The claimed invention, as provided in amended independent claims 1, 6 and 7 contain features, which are patentably distinguishable from the prior art references of record.

[0018] Applicants submit that Chan, alone or in combination with Patrick, and/or Muehlen fails to disclose, teach or even suggest at least the features directed to: 1) constructing a set of possible workflows meeting a workflow specification having a predetermined input and a required output, using components having defined inputs and outputs; 2) calculating an exposure cost measure for each of the possible workflows in the set of possible workflows, said exposure cost measure being based upon, in part, details of critical information that is temporarily stored between processing steps within each of said possible workflows; 3) selecting a target workflow from the constructed set of possible workflows for which the exposure cost measure is calculated

to be a minimum, as recited in independent claim 1 and similarly recited in independent claims 6 and 7.

[0019] Applicants re-state the arguments of the March 4, 2009 which are incorporated herein by reference. Applicants further note that Hung (previously cited as Patrick) describes a system designed to reduce reliance on any one individual agent. That is, the focus of the SRF and SRV is to facilitate assignment of a workflow to different agents consistent with the privileges of the agent in the pool. Thus, Hung analyzes the agents and their associated privileges. In contrast, Applicants claims recite “said exposure cost measure being based upon, in part, details of critical information that is temporarily stored between processing steps within each of said possible workflows” which is absent from Hung. Thus, the independent claims define patentable subject matter over Hung.

[0020] The 6/5/2009 Communication states that the combined teachings of Chan et al. and Patrick [Hung] do not explicitly teach an exposure cost measure being based upon, in part, details of critical information that is temporarily stored between processing steps within each of said workflows.” (6/5/2009 Communication, p. 14, ll. 18-20) Applicants agree. The 6/5/2009 Communication attempts to remedy these deficiencies by combining Chan-Hung with Muehlen.

[0021] As previously noted in para. 30 of Applicants’ 3/4/2009 Response, the non-patent reference Muehlen merely provides a framework explicitly stating that “[t]he active feedback of evaluation data on the modeling of workflow processes is a promising candidate for further research.” Moreover, Muehlen’s asserted computation of “[p]rocess cycle times, lay- and idle times (i.e., unused or “temporarily stored” resources...” fails to address the feature of “[c]alculating an exposure cost measure for each of the possible workflows in the set of possible

workflows, said exposure cost measure being based upon, in part, details of critical information that is temporarily stored between processing steps within each of said possible workflows...” as recited in independent claims 1, 6 and 7.

[0022] Applicants note that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

VI. Formal Matters and Conclusion

[0023] With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

[0024] In view of the foregoing, Applicants submit that claims 1-15, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

[0025] Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

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